

# TRANSMITTAL FORM

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Total Number of Pages in This Submission

Application Number	09/777,274
Filing Date	February 5, 2001
First Named Inventor	Jean Paul Marcade et al.
Art Unit	3738
Examiner Name	David H. Willse
Attorney Docket No.	BSI-556US6

## ENCLOSURES (Check all that apply)

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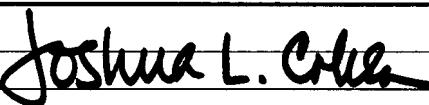
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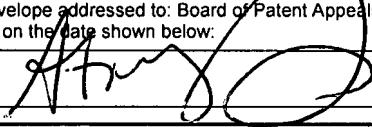
## SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm Name	RatnerPrestia		
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Date	November 21, 2007	Registration No.	38,040

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No: 09/777,274  
Appeal No: 2007-2500  
Appellants: Jean Paul Marcade et al.  
Filed: February 5, 2001  
Title: BIFURCATED GRAFT WITH AN INFERIOR EXTENSION  
T.C./A.U.: 3738  
Examiner: David H. Willse  
Confirmation No.: 3685  
Notice of Appeal Filed: January 16, 2006  
Docket No.: BSI-556US6

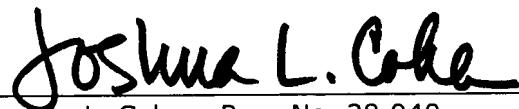
SUBMISSION OF REQUEST FOR REHEARING

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

SIR :

In response to the Decision on Appeal dated September 24, 2007, Appellants submit herewith this Request for Rehearing for the above-identified application.

Respectfully submitted,

  
\_\_\_\_\_  
Joshua L. Cohen, Reg. No. 38,040  
Attorney and Agent for Appellants

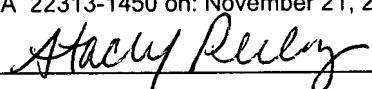
Attachment: Request for Rehearing

Dated: November 21, 2007

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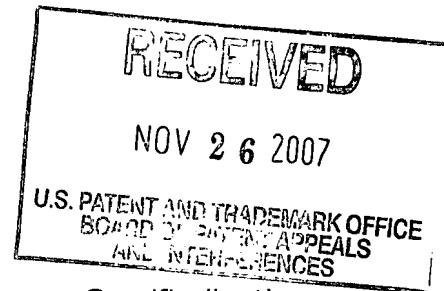
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Stacy Riley

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No: 09/777,274  
Appeal No: 2007-2500  
Appellants: Jean Paul Marcade et al.  
Filed: February 5, 2001  
Title: BIFURCATED GRAFT WITH AN INFERIOR EXTENSION  
T.C./A.U.: 3738  
Examiner: David H. Willse  
Confirmation No.: 3685  
Notice of Appeal Filed: January 13, 2006  
Docket No.: BSI-556US6

**REQUEST FOR REHEARING**

Appellants request rehearing of this Appeal for several reasons. Specifically, the Decision on Appeal of September 24, 2007 ("Decision") includes the following points that the Board has misapprehended or overlooked:

I. The Decision includes a construction of the term "configured to mate" that is inconsistent with the record. For this reason, Appellants ask the Board to restate the construction of the term "configured to mate."

II. The Decision is based on an erroneous presumption that "[t]he second leg 8 [of the Martin reference] has the same diameter as the extender 18." For this reason, Appellants ask the Board to reconsider the rejection based on Martin.

III. The Board has overlooked significant structural differences between the bottom end 6 of the graft 2 of Martin and the short tube graft 8 of Martin. For this reason, Appellants ask the Board to reconsider whether the straight tube graft 18 of Martin is necessarily or inevitably configured to mate with the bottom end 6 of the graft 2 of Martin.

Detailed arguments with respect to each of these reasons for rehearing are set forth below.

I. The Construction of the Term "Configured to Mate" Stated in the Decision is Inconsistent with the Record

At Page 4 of the Decision, the following statement is made about the construction of the term "configured to mate":

According to Appellants' argument in the Reply Brief, "configured" means to form or shape. Thus, "configured to mate" is construed in this context as being the same shape and diameter.

This construction of the term "configured to mate" as being the same shape and diameter is inconsistent with the record. Most significantly, it is not supported by, and is inconsistent with, Appellants' specification.

Appellants agree that the term "configured" means to form or shape. But this construction does not lead to the conclusion that "configured to mate" means the same shape and diameter. Instead, "configured to mate" simply means formed or shaped to mate.

A construction of the term "configured to mate" to require the *same* shape and the *same diameter* contradicts Appellants' specification. Embodiments within the scope of Appellants' invention may or may not include components having the same shape or the same diameter. They may indeed have different shapes and/or different diameters.

Regarding shape, at least one embodiment disclosed in Appellants' specification is optionally provided with a first graft 114 having various configurations as compared to the leg 132 of the main body 130:

In contrast to the tapered configuration of primary graft 110, grafts 114 and 116 may have a substantial uniform diameter along their entire lengths between the proximal and distal ends. However, it is contemplated that grafts 114 and 116 may have a tapered configuration similar to that of graft 110, wherein the diameter of the graft may either increase or decrease from the proximal to the distal end thereof. ... Leg 132 may have a generally cylindrical shape with a substantially uniform diameter from its juncture with main body 130 to the free end thereof. (Specification at Page 18, Line 11 to Page 19, Line 3)

Accordingly, the first graft 114 may or may not have the same shape as leg 132. First graft 114 and leg 132 may both have substantially uniform diameters along their length. But first graft 114 may also have a tapered configuration as compared to a leg 132 having a substantially uniform diameter.

Regarding respective diameters, at least one embodiment disclosed in Appellants' specification includes a leg 132 having a different diameter as compared to that of graft 114:

Forming leg 132 of base member 112 with a diameter in the fully expanded condition which is larger than the fully expanded diameter of graft 114 will assure that the foregoing assembly procedure securely locks base member 112 and graft 114 together and forms a seal which prevents the leakage of blood from therebetween. (Specification at Page 31, Lines 28-34)

Accordingly, leg 132 of base member 112 in one embodiment has a diameter that is larger than that of graft 114.

Embodiments within the scope of Applicants' invention may or may not have the same shape and/or the same diameter. Accordingly, the construction of the term "configured to mate" stated in the Decision is inconsistent with Appellants' specification.

For the foregoing reasons, Appellants ask the Board to restate the construction of the term "configured to mate" and request confirmation that the term "configured to mate" should be construed to mean formed or shaped to mate.

II. It is Erroneous to Presume that Short Tube Graft 8 of Martin has the Same Diameter as the Straight Tube Graft 18 of Martin

Claim 67 requires an extender (e.g., 114) in the form of a graft, the extender configured to mate with a first leg (e.g., 132) after a body (e.g., 112) is placed in vasculature. The extender is therefore configured to mate with the longer leg of the body.

The rejection of claim 67 based on Martin is justified by the following analysis in the Decision at Page 4:

[1] [T]he diameter of the leg [of Martin] that has an outlet at 6 overlaps with the diameter of the shorter tube graft of second leg 8.

[2] The second leg 8 presumably has the same diameter as the extender 18. See Figure 5.

[3] Accordingly, for some embodiments of the graft of Martin, the extender would have the same diameter as the outlet 6.

This analysis is based on an erroneous presumption in step [2] above.

More specifically, the Decision states the following explicit presumptions regarding the structure of the straight tube graft 18 and the short tube graft 8 of the Martin reference:

The extender or straight tube graft 18 is presumed to be the diameter of graft 8, i.e., from 4mm.-8mm. See Figure 5.  
(Decision at Page 3)

The second leg 8 presumably has the same diameter as the extender 18. See Figure 5.  
(Decision at Page 4)

But there is no support for this presumption.

The discussion in Section I regarding the construction of the term "configured to mate" provides a first reason why the straight tube graft 18 can not be presumed to be the diameter of graft 8. Straight tube graft 18 may or may not be the diameter of graft 8. For example, the diameter of straight tube graft 18 may be made larger or smaller than that of graft 8 in order to overlap those structures according to the Martin disclosure:

A straight tube graft 18 may then [be] positioned to overlap the short tube graft 8 and to extend towards the common femoral artery, and angioplasty may then be undertaken to fully expand graft 18, if necessary. (Martin at Column 4, Lines 15-18)

Also, there is no disclosure in Martin regarding the relative diameters of the straight tube graft 18 and the short tube graft 8. And the mere illustration in Figure 5 of Martin is insufficient to disclose the relative diameters of those structures.

For these reasons, Appellants ask the Board to reconsider the rejection based on Martin in that it is premised on an unsupported presumption.

III. The Significant Structural Differences Between the Bottom End 6 of Graft 2 of Martin and the Tube Graft 8 of Martin have been Overlooked

The rejection of claim 67 is based on inherent anticipation, which requires that "the claimed invention necessarily or inevitably flows from the prior art." Decision at Page 4. Fundamental to the analysis in the Decision is a conclusion that the straight tube graft 18 of Martin, which is positioned to overlap the short tube graft 8 of Martin, is necessarily or inevitably configured to mate with the bottom end 6 of Martin's graft 2.

But there are at least three (3) structural differences between the bottom end 6 of Martin's graft 2 and Martin's short tube graft 8. These structural differences, which have been overlooked, are summarized in the following table:

	<b>Short tube graft 8</b>	<b>Bottom end 6 of graft 2</b>
<b>Different diameter openings</b>	Ø 4-8 mm (Column 2, Line 66)	Ø 3-6 mm (Column 2, Lines 63 and 65)
<b>Different shape</b>	Tube graft 8 appears cylindrical (Fig. 1)	Graft 2 tapers from 10 mm to 4 mm or from 8 mm to 3 mm (Fig. 1 and Column 2, Line 65)
<b>Stented or not</b>	End not stented (Fig. 4 and Column 3, Lines 5-7)	Stented (Figs. 1 and 4)

Because of these significant structural differences, the straight tube graft 18 of Martin is not necessarily or inevitably configured to mate with the bottom end 6 of Martin's graft 2. A tube graft 18 that overlaps a tube graft 8 is not necessarily or inevitably configured to mate with a bottom end 6 of graft 2. Also, a *straight* tube graft 18 that overlaps the tube graft 8 is not necessarily or inevitably configured to mate with a *tapered* bottom end 6 of graft 2. And a tube graft 18 that overlaps an *unstented* tube graft 8 is not necessarily or inevitably configured to mate with a *stented* bottom end of graft 2.

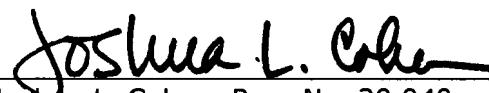
For the foregoing reasons, Appellants ask the Board to reconsider whether straight tube graft 18 of Martin is necessarily or inevitably configured to mate with bottom end 6 of Martin. Specifically, Appellants respectfully request the withdrawal of the rejection as failing to establish inherent anticipation.

In conclusion, Appellants request rehearing of this appeal and specifically request:

- I. Restatement of the construction of the term "configured to mate."
- II. Reconsideration of a presumption made in the rejection based on Martin.
- III. Reconsideration of whether the straight tube graft 18 of Martin is necessarily or inevitably configured to mate with the bottom end 6 of the graft 2 of Martin.

Favorable rehearing is respectfully requested.

Respectfully submitted,

  
\_\_\_\_\_  
Joshua L. Cohen, Reg. No. 38,040  
Attorney and Agent for Appellants

Dated: November 21, 2007

P.O. Box 980  
Valley Forge, PA 19482-0980  
(610) 407-0700

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